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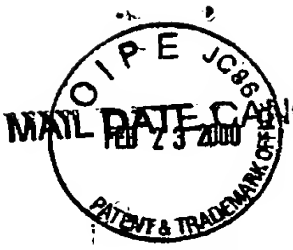

MAIL DATE CANCELLED

PATENT

Attorney Docket No.: A-55320-2/RFT/TAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

PHILIPPE POULETTY

Serial No. 08/630,383

Filed: April 10, 1996

For: CYTOMODULATING CONJUGATES OF MEMBERS OF SPECIFIC BINDING PAIRS

Examiner: Schwadron, R.

Group Art Unit: 1644

#20

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DATE OF DEPOSIT February 22, 2000

I HEREBY CERTIFY THAT THIS PAPER OR FEE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE "EXPRESS MAIL POST OFFICE TO ADDRESSEE" SERVICE UNDER 37 CFR 1.10 ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO: ATTENTION: OFFICE OF PETITIONS, ASSISTANT COMMISSIONER FOR PATENTS, BOX DAC, WASHINGTON, DC 20231.

TYPED NAME Hammid Sanchez

SIGNED

PETITION FOR REVIVAL OF AN APPLICATION FOR A PATENT UNINTENTIONALLY ABANDONED UNDER 37 C.F.R. §1.137(b)

Attention: Office of Petitions
Assistant Commissioner for Patents
BOX DAC
Washington, DC 20231

Sir:

Applicant hereby petitions for revival of the above-identified application under 37 C.F.R. §1.137(b) on the ground that the entire delay in filing the required reply until the filing of this grantable petition under 37 C.F.R. 1.137(b) was unintentional.

A request for filing a CPA pursuant to 37 C.F.R. §1.53(d) is submitted herewith in response to the Final Office Action mailed December 13, 1996. Also enclosed is the petition fee set forth in 37 C.F.R. 1.17(m). The Commissioner is hereby authorized to charge any additional fees, including extension fees, or refund any overpayment to Deposit Account 06-1300 (Our Order No. A-55320-2/RFT/TAL).

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STATEMENT OF THE FACTS

The above-identified application was transmitted to the United States Patent and Trademark Office on April 10, 1996 as a continuation-in-part of U.S. Patent Application Serial No. 08/254,299, filed June 6, 1994, which is in turn a continuation of U.S. Patent Application Serial No. 07/690,530 filed April 23, 1991. It identified the law firm of Flehr Hohbach Test Albritton & Herbert LLP (the firm) and Bertram I. Rowland in particular as the applicant's representative. Shortly thereafter, Dr. Mark T. Kresnak was assigned as the working attorney responsible for prosecution of the file. [Declaration of Dr. Mark T. Kresnak ("Kresnak Decl."), ¶ 1].

A Final Office Action was mailed on July 1, 1997, requiring a response by October 1, 1997. A Notice of Appeal and the requisite fee were timely submitted with a Certificate of Mailing dated September 29, 1997. Subsequently, on December 31, 1997 Petitioner filed an Amendment After Final responding to the issues raised in the Final Office Action, together with a Petition for a two-month extension of time. In continuing compliance with its disclosure obligations under 37 C.F.R. §1.56, Petitioner further submitted a Supplemental Information Disclosure Statement on February 9, 1998, in order to make of record various references cited in a corresponding International Search Report dated January 23, 1998.

The Examiner responded to Petitioner's Amendment After Final with an Advisory Action mailed February 3, 1998, in which he refused entry of petitioner's proposed amendments on the grounds that, *inter alia*, they would raise the issue of new matter and would require new consideration and search. In reply, Petitioner submitted a Communication Under 37 C.F.R. §1.129 requesting application of transitional after final practice, along with the appropriate fee under 37 C.F.R. §1.17(r) as well as a petition for a third month extension of time and the fee therefor. [Kresnak Decl., ¶ 2].

The next communication received from the Patent and Trademark office in the subject application was a Defective Notice of Appeal or Brief mailed on May 18, 1998, in which the Examiner indicated that Petitioner's submission under Rule 129 was not acceptable because the subject application was filed after June 8, 1995. The communication further reported that the appeal was dismissed and the application abandoned since no appeal brief was filed within six months of the Patent Office date of receipt of the timely Notice of Appeal on October 7, 1997.

Petitioner through its attorney Dr. Kresnak then filed a Response to Defective Notice of Appeal or Brief on October 2, 1998, citing a notification in the Official Gazette in support of Petitioner's interpretation of continuing prosecution practice. [Kresnak Decl., ¶ 3]. No response was ever received from the PTO to this submission.

Dr. Kresnak left the Flehr firm in April 1999, at which point responsibility for the subject application was transferred to the undersigned attorney, Todd A. Lorenz. With no intervening Patent Office communications to draw attention to it, the subject application file was first reviewed in connection with the receipt of a final decision from the Board of Patent Appeals and Interferences in the grandparent case (the '530 application), at which point a comprehensive review of all of the related application files was undertaken. [Declaration of Todd A. Lorenz ("Lorenz Decl."), ¶ 2]. It was at this time that the undersigned attorney, upon reviewing the communications in the file, became concerned about the pendency of the application in view of the lack of response from the PTO to Petitioner's submission dated 10/2/98. [Lorenz Decl., ¶ 3]. An inquiry was then made to Examiner Schwadron regarding the status of the file, and after being informed that the case was presently abandoned and no response was planned to Petitioner's communication of 10/2/98, Petitioner and its attorneys proceeded with the preparation of the instant petition. [*Id.*].

At no time did Petitioner or any of its attorneys indicate an intent to abandon the subject application. To the contrary, Petitioner through its attorneys has diligently pursued the case based on its attorney's interpretation of the applicable statutes and regulations, and every effort was made to comply with PTO procedure. Indeed, the dormancy of the application from the date of abandonment to the date of filing the instant petition is in significant part a result of the lack of communication from the PTO in response to an inquiry by Petitioner's attorney regarding the application of Rule 129 practice to the case.

ARGUMENT

Revival of abandoned applications or lapsed patents is governed by 37 C.F.R. §1.137. Rule 137 requires that the petition contain a statement that the entire delay in filing the required reply from the due date until the filing of a grantable petition was either unavoidable (under section (a)) or unintentional (under section (b)). The determination of whether an abandonment of an application is intentional under §1.137(b) must be made on a case-by-case basis. *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989).

With regard to unintentional delay, the Patent Office has stated:

> [T]here is a distinction between: (1) a delay resulting from an error in judgment as to whether to permit an application to become abandoned (whether to prosecute the application) or whether to seek or persist in seeking the revival of the abandoned application; and (2) a delay resulting from an error in judgment as to the steps necessary to continue the prosecution delay in seeking revival of the application. Where the abandonment and ensuing delay results from an error in judgment as to whether to permit an application to become abandoned (whether to prosecute the application) or whether to seek or persist in seeking the revival of the abandoned application, the abandonment of such application is considered a deliberately chosen course of action, and the resulting delay cannot be considered "unintentional" within the meaning of 1.137(b). Where, however, an error in judgment as to the steps necessary to continue prosecution results in abandonment of the application, the abandonment of such application is not necessarily considered a deliberately chosen course of action, and the resulting delay may be considered "unintentional" within the meaning of 1.137(b).

Changes to Patent Practice and Procedure, Final Rule Notice, 1203 *Off. Gaz. Pat. Office* at 89. [Emphasis added].

As clearly demonstrated by the foregoing facts, at no time did Petitioner or its attorneys deliberately choose a course of action to intentionally abandon the subject application. Indeed, the facts presented above demonstrate the contrary: Petitioner's attorney believed in good faith that the response under §1.129 was appropriate to ensure continued prosecution of the instant application, and actively sought guidance and input from the Examiner on the basis for his rejection of the request. At no point did Petitioner or its attorneys indicate or evidence any intent to abandon the application. To the extent there may have been a misinterpretation of Rule 129 practice, this merely constituted an "error in judgment" as to the steps necessary to continue prosecution. The delay in filing the instant petition is certainly not a deliberately chosen course of action which could constitute an intentional delay.

CONCLUSION

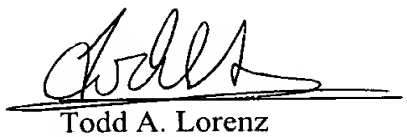
Submitted herewith are: (1) Request for Filing a CPA Under 37 C.F.R. §1.53(d) and accompanying fee; (2) Declaration of Dr. Mark T. Kresnak setting forth some of the circumstances surrounding the delay; (3) Declaration of Todd A. Lorenz setting forth some of

the circumstances surrounding the delay; and (4) Petition fee under 37 C.F.R. 1.17(m) for revival of the abandoned application.

As should be apparent, the entire delay in filing the required reply until the filing of this grantable petition was unintentional. Accordingly, it is requested that the application be revived and forwarded to the examination division for prosecution.

Respectfully submitted,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP



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